# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/884,921 | 06/21/2001 | Marco Peretti | 702265.0007 | 6896 |

23911          7590          10/19/2005

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

| EXAMINER |
|---|
| REVAK, CHRISTOPHER A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2131 | |

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| | 09/884,921 | PERETTI, MARCO |
| **Office Action Summary** | Examiner | Art Unit | |
| | Christopher A. Revak | 2131 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 July 2005*.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3,5-19,22-29 and 31-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-14,16-19,22-29 and 31-33* is/are rejected.

7)☒ Claim(s) *5 and 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1.     Applicant's arguments with respect to claims 1-3,5-19,22-29, and 31-33 have

been considered but are moot in view of the new grounds of rejection.

2.     The rejection of claims 7,21, and 29 under 35 USC 112 2nd paragraph is hereby

withdrawn by the examiner.

### *Claim Objections*

3.     Claim 5 is objected to because of the following informalities:  Claim 5 was

amended to recite that it depends upon itself.  It appears that claim 5 was intended to

depend upon independent claim 1.  Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

4.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.     Claims 1-3,5-14,16-19,22-29, and 31-33 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Bharat, U.S. Patent 6,577,735 in view of Golan, U.S. Patent

5,974,549.

As per claims 1,18, and 22, Bharat discloses of a method, apparatus, and computer readable medium containing embedded software for backing up (shadowing) only accesses to audio data stored on a portable audio player comprising a compact disk (external storage media)(col. 3, lines 47-53 and col. 4, lines 25-28). Input/Output access is detected to the compact disk (external storage medium). A copy of the accessed data is written onto the computer's hard disk (location other than the external storage medium)(col. 3, lines 47-55). The teachings of Bharat are silent in disclosing intercepting an I/O request from the computer to an external storage media drive. The teachings of Golan disclose of intercepting an I/O request from the computer to downloaded code from the Internet (external storage media drive)(col. 2, lines 22-28 & 42-57). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to intercept requests so that if a malicious action is occurring, it could be diverted to avoid inflecting harm to a computer. The teachings of Golan disclose of motivational benefits by reciting of securing unknown software downloaded from an external source (col. 1, lines 4-8). It is obvious that the teachings of Bharat would have been further protected from unknown software loaded from an external source as is disclosed by Golan.

As per claims 2 and 19, it is taught by Golan of access being a write operation (col. 2, lines 34-38), please refer above for the motivation of combining the teachings of Golan to the disclosure of Golan.

As per claim 3, Bharat discloses of accessing being a read operation (col. 5, lines 22-25).

As per claim 5, Bharat discloses of the I/O request includes both read and write requests (col. 5, lines 22-25).

As per claims 6 and 23, it is taught by Bharat of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60).

As per claims 7,21,24, and 25, the teachings of Bharat disclose of use of an operating system stored in the system memory (col. 4, lines 27-30). It is interpreted by the examiner that the operating system can be instructed to perform commands such as IRP_MJ_READ and IRP_MJ_WRITE since they vary depending upon how the developer identified the code to be executed. Bharat does disclose of both read and write operations (col. 5, lines 22-25).

As per claim 8, Bharat discloses of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60). It is interpreted by the examiner that the operating system can be instructed to perform commands such as IRP_MJ_READ and IRP_MJ_WRITE since they vary depending upon how the developer identified the code to be executed. Bharat does disclose of both read and write operations (col. 5, lines 22-25).

As per claim 9, the teachings of Bharat disclose of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60). It is interpreted by the examiner that the operating system can be instructed to perform a command such as IRP_MJ_READ

since they vary depending upon how the developer identified the code to be executed.

Bharat discloses read operations (col. 5, lines 22-25).

As per claim 10, Bharat teaches that the data stored on the computer's hard disk

(location other than the external storage medium) is stored as an encrypted file

(protected storage location)(col. 3, lines 47-54).

As per claim 11, Bharat discloses of writing the data to the portable jukebox

(comprising an external storage medium) after the step of writing a copy of the data to

the computer's hard disk (location other than the external storage medium)(col. 3, lines

47-55 and col. 8, lines 4-24).

As per claim 12, it is taught by Bharat of attaching file systems connected to an

external storage medium drive in which the external storage medium is connected and

intercepting the I/O request from the computer to the compact disk (external storage

medium) drive in which the compact disk (external storage medium) is inserted to check

for authenticity (col. 7, lines 48-60).

As per claim 13, it is disclosed by Bharat that the external storage medium is a

compact disk (col. 3, lines 51-53).

As per claim 14, the teachings of Bharat disclose of storing the accessed data

onto the computer's hard disk (database)(col. 3, lines 47-55). It is interpreted by the

examiner that this information can be queried since it contains similar copies.

As per claim 16, Bharat discloses of the computer is connected to a computer

network and the detecting and copying is performed at the computer (col. 3, lines 47-55

and col. 4, lines 19-22). Collecting and querying is performed using the CDDB at

another computer on the network (col. 4, lines 19-22 and col. 5, lines 43-46).

As per claim 17, Bharat teaches of collecting and querying is performed by a

user who is authorized (with administrator privileges)(col. 6, lines 57-61).

As per claim 26, Bharat discloses of a file handling system (proxy handler) for the

I/O requests and executing it in response to detection of media in the drive (col. 4, lines

31-34 and col. 7, lines 55-60). File identifiers are stored in a list (col. 3, lines 1-8).

As per claim 27, Bharat discloses that the file identifiers are serial numbers

(IRP.FsContext values)(col. 3, lines 1-8).

As per claim 28, Bharat discloses of a file handling system (proxy handler) for the

I/O requests and executing it in response to detection of media in the drive. The

number of iterations (certain file operations) is counted in determining authenticity of the

compact disk (external storage medium) after failing to do so (col. 4, lines 31-34 and

col. 7, lines 55-60).

As per claim 29, Bharat discloses of the computer running an operating system

and that includes a file handling system (proxy handler) for the I/O requests and

executing it in response to detection of media in the drive (col. 4, lines 25-34 and col. 7,

lines 55-60).

As per claims 31-33, it is disclosed by Bharat that the external storage medium is

a compact disk (col. 3, lines 51-53). The teachings of Golan are relied upon for

disclosing of a writable media, please refer above for the motivation of combining the

teachings of Golan to the disclosure of Golan.

### *Allowable Subject Matter*

6.     Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

1.     Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794.  The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.  Status information for published applications may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished applications is available through Private PAIR only.  For more information about the PAIR system, see http://pair-direct.uspto.gov.  Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Revak
Primary Examiner
AU 2131

CR

October 17, 2005